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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,589	01/31/2002	Roger Q. Roberts	2860	3409
26822	7590	06/30/2004	EXAMINER	
WALTER A. HACKLER 2372 S.E. BRISTOL, SUITE B NEWPORT BEACH, CA 92660-0755			HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/062,589	Applicant(s) ROBERTS ET AL.	
	Examiner Dwayne K Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 17-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/31/02, 3/29/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a well plate seal, classified in class 422, subclass 101.
 - II. Claims 17-19, drawn to a method of providing flow control, classified in class 436, subclass 178.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus can be used to store biological materials in the wells of the claimed member.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
3. During a telephone conversation with Mr. Walter Hackler on 6/10/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 7-9 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Kedar et al. (6,083,761). Kedar teach a method of combining and transferring reagents in stacked plates. The embodiment of most relevance to the instant claims is shown in Figures 4, 5D, and 5E. As shown in Figure 4, the device is comprised of two elements, an upper element (12) having wells that are placed over and into the exits of the wells (22) of the lower element (14). Compounds are mixed and reacted in the wells of the upper plate and then transferred to the lower plate

Art Unit: 1743

through centrifugation, vacuum or other forces (col. 10, lines 30-39). In Figures 5D and 5E, Kedar shows an embodiment with a tapered well having a "transitory hole" (34') that is flexible and normally closed. Upon centrifugation or application of vacuum, the hole flexes open and allows for the passage of fluid. When the force is removed, the hole closes again (col. 13, line 62 – col. 14, line 6). The Examiner considers this feature to be a unidirectional valve as required in the independent claim. As for the limitation of "flexible", Kedar makes the device from plastic that is flexible enough to have the "transitory hole" that forms the valve in the bottom of the upper plate. Also, applicant has placed no limitation on the "flexible matt" other than it being "for facilitating removable engagement with the....plate exit port". For these reasons, the Examiner believes the plate of Kedar meets the limitation of flexible.

Inventorship

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1743

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 4-6, 10-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kedar et al. (6,083,761) in view of Harris (4,473,094). Kedar teaches every element of claims 4-6 and 10-12 except for the use of a duck billed valve. Kedar teaches a valve that operates in only one direction, but not a duckbilled valve. Harris teaches an air inlet that admits filtered gases into a fluid container which has a duck billed valve in the inlet housing. The presence of the duck billed valve prevents fluid from contacting the air filter to reduce the risk of bacterial contamination due to back flow through the valve (Abstract, col. 4, lines 1-23). It would have been obvious to one of ordinary skill in the art to combine the duck billed valve from Harris with the device of

Art Unit: 1743

Kedar. One would add the duck billed valve from Harris to prevent fluid from flowing back through the valve while drawing fluid through the valve and into the lower plate.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kedar et al. (6,054,325) repeats the previously cited Kedar teachings. Feygin et al. (6,315,957) teach a plate with filter pockets. Root et al. (4,895,706) teach filter assemblies comprised of well strips. Fernwood et al. (5,141,719) show a filtration plate assembly. Steinel (6,666,978) displays an apparatus for applying a vacuum to a microplate. Bodner et al. (6,338,802), Mansky et al. (6,455,007), Bankier et al. (5,846,493), Roberts et al. (6,491,873), Grant et al. (5,624,815) and Blevins et al. (5,906,796) teach filtration devices. Gamble (6,106,783) shows a closure for microplate wells. Jitsukawa (4,931,400) shows a device for pouring water onto multiwell plates. Munzer et al. (4,197,735) show a blood sedimentation rate test vessel with a biased valve.


11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
June 25, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700